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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN HARRIS, SEAN KELLEY, and TERO HENTTONEN

Appeal 2018-002790
Application 14/819,076
Technology Center 2400

Before ERIC S. FRAHM, BETH Z. SHAW,
and NORMAN H. BEAMER, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–3, 5, 6, 8, 9, 16–18, 20, 21, 23, 24, 31, 32, and 34–36. Claims 4, 10, 19, 25, 33, 37, and 38 are objected to. (Ans. 5.) Claims 7, 11–15, 22, and 26–30 are cancelled. We have jurisdiction over the pending rejected claims under 35 U.S.C. § 6(b).

We reverse.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant states that it believes the real party in interest is Nokia Solutions and Networks Oy. (Appeal Br. 2.)

CLAIMED SUBJECT MATTER

Appellant's disclosed and claimed invention is directed to providing cellular network insights, such as cellular network conditions, based on virtual international mobile subscriber identities (IMSI) included in paging messages. (Abstr.) Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method, comprising:

detecting, by a device, at least one paging message over a cellular system; and

extracting, from the at least one paging message, at least one cellular network insight comprising at least one cellular network condition,

wherein the cellular network insight is encoded by an order in which page addresses are conveyed in the paging message.

(Appeal Br. 28 (Appendix 1).)

REJECTIONS

The Examiner rejected claims 1, 5, 6, 8, 9, 16, 20, 21, 23, 24, and 34 under 35 U.S.C. § 103 as being unpatentable over Diachina et al. (US 2014/0329550 A1, pub. Nov. 6, 2014), Yang et al. (US 2008/0081613 A1, pub. Apr. 3, 2008), and Fujii (US 2014/0215119 A1, pub. July 31, 2014). (Final Act. 2–4.)

The Examiner rejected claims 2, 3, 17, 18, 31, 32, 35, and 36 under 35 U.S.C. § 103(a) as being unpatentable over Diachina, Yang, Fujii, and Kim et al. (US 2013/0051228 A1, pub. Feb. 28, 2013). (Final Act. 4–5.)

ISSUE ON APPEAL

Appellant’s arguments present the following issue²:

Whether the Examiner erred in finding the combination of Diachina, Yang, and Fujii would have taught or suggested the independent claim 1 limitation, “wherein the cellular network insight is encoded by an order in which page addresses are conveyed in the paging message,” and the commensurate limitations of independent claims 9, 16, and 24. (Appeal Br. 12–16, 18–19, 21–22.)

ANALYSIS

For the claim limitation at issue, the Examiner finds that Diachina “is silent” regarding encoding a cellular network insight by an order in which page addresses are conveyed in the paging message, but relies on the disclosure in Yang of conveying multiple addresses a paging message, and on the disclosure in Fujii of performing ring buffer read operations in the opposite order of write operations, and finds the combination teaches or suggests the limitation. (Final Act. 3.)

Appellant argues, and we agree, the multiple addresses included in the paging message of Yang are not used to convey information, other than to identify the devices to which the message is sent — *i.e.*, the order of the addresses in the message conveys no information. (Appeal Br. 11, 14; Yang Fig. 6, ¶ 9.)

² Rather than reiterate the arguments of Appellant and the findings of the Examiner, we refer to the Appeal Brief (filed Nov. 2, 2017) (“Appeal Br.”); the Reply Brief (filed Jan. 19, 2018) (“Reply Br.”); the Final Office Action (mailed July 5, 2017) (“Final Act.”); and the Examiner’s Answer (mailed Dec. 22, 2017) (“Ans.”) for the respective details.

Appellant further argues Fujii is non-analogous art, because it relates to control of a storage device, including reading data from storage addresses in the opposite order of writing. (Appeal Br. 14; Fujii Abstr., ¶¶ 9, 42.) We agree. As held in *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011):

Two *separate* tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

Fujii is directed to the field of storage technology, a different field from the cellular network technology of Appellant's subject matter. (Fujii, Abstr.) Nor is the method of reading from, and writing data to, storage disclosed in Fujii reasonably pertinent to the problem of conveying cellular network insights to network devices. Therefore, we agree that Fujii is non-analogous art. Moreover, even if considered, Fujii, like Diachina and Yang, provides no teaching or suggestion that the order of addresses, whether in a paging message or some other context, can be used to convey information.

The Examiner cites *In re Keller*, 642 F.2d 413 (CCPA 1981), which emphasizes that the references relied on should be considered in combination, rather than individually. (Ans. 6–7.) However, as discussed above, nothing in the combination on which the Examiner relies provides any teaching or suggestion of encoding cellular network insight by an order in which page addresses are conveyed in the paging message.

Accordingly, the Examiner has not made out a *prima facie* case of obviousness, and we do not sustain the Examiner's obviousness rejections of

independent claims 1, 9, 16, and 24 as obvious over Diachina, Yang, and Fujii. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

We also do not sustain the Examiner’s rejections of claims 5, 6, 8, 20, 21, 23, and 34 over Diachina, Yang, and Fujii, which claims depend from claims 1, 9, or 16. The Kim reference is not relied on for the limitation at issue. (Final Act. 4–5.) Therefore, we also not sustain the Examiner’s rejections of claims 2, 3, 17, 18, 31, 32, 35, and 36 over Diachina, Yang, Fujii, and Kim, which claims depend from claims 1, 9, 16, or 24.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 5, 6, 8, 9, 16, 20, 21, 23, 24, 34	103	Diachina, Yang, Fujii		1, 5, 6, 8, 9, 16, 20, 21, 23, 24, 34
2, 3, 17, 18, 31, 32, 35, 36	103	Diachina, Yang, Fujii, Kim		2, 3, 17, 18, 31, 32, 35, 36
Overall Outcome				1–3, 5, 6, 8, 9, 16–18, 20, 21, 23, 24, 31, 32, 34–36

REVERSED